

REMARKS**1. Examiner's Interview**

The undersigned attorney appreciates the telephonic interview provided by Examiner Thompson on June 8, 2004 to discuss the Final Office Action. The following topics were discussed:

- The finality of the May 12, 2004 Office Action (this was briefly discussed, but no agreement was explicitly reached). Further comments are set forth in Section 3 of this Response.
- The §112(2) rejections, as discussed at Section 4 of this Response. It was agreed that amendments to claims 1-13 and 21 to amend the preamble to recite a structure (as opposed to a strip) would clarify the claims to overcome the rejections.
- The art-based rejections, as discussed at Section 5 of this Response. The references of record (particularly U.S. Patent 5,648,138 to *Tingley*) were discussed in detail, and it was agreed that the art-based rejections should be withdrawn.

Further comments are set forth in the above-referenced sections of this Response.

2. The Amendments, the Support Therefor, and Basis for Entry

No claims have been canceled, no new claims have been added, and claims 1-13 and 21 have been amended to address the §112(2) rejections (as discussed in Section 4 of this Response) to leave claims 1-13 and 19-34 in the application. No new matter has been added by the amendments or new claims. As per 37 CFR §1.116(b) and MPEP 714.12/714.13, the amendments place the case either in condition for allowance or in better form for appeal, and thus are believed to be suitable for entry.

3. Finality of Office Action/Entry of Amendments

In the event that the current claims are not found allowable, finality of the Office Action should be withdrawn pursuant to MPEP 706.07(a) ("Final Rejection, When Proper on Second Action"). This provision states:

Under present practice, second or any subsequent actions on the merits shall be final, *except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims* nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

(Emphasis added.) In this case:

- In the prior Office Action of 22 December 2003, claim 19 was rejected under §103 in view of U.S. Patent 5,648,138 to *Tingley* and U.S. Patent 5,637,375 to *Hohman* (see section 9, page 4 of that Office Action).
- In the last Response of 23 February 2004, claim 19 was not amended, and section 4, page 9 of the Response submitted arguments for withdrawal of the §103 rejection in view of U.S. Patent 5,648,138 to *Tingley* and U.S. Patent 5,637,375 to *Hohman*.
- No information disclosure statement was filed during the noted period.
- In the Final Office Action of 12 May 2004, the above-noted rejection of claim 19 was withdrawn and replaced by a rejection under §103 in view of U.S. Patent 5,648,138 to *Tingley*, U.S. Patent 5,640,825 to *Ehansi et al.*, and U.S. Patent 5,637,375 to *Hohman* (see section 12, page 6 of that Office Action). Page 8 of the Office Action states that this is a new rejection.

Finality is therefore premature as per MPEP 706.07(a), since a new ground of rejection was introduced, and it was not necessitated by any amendment of the claims (nor by a newly-submitted Information Disclosure Statement). Thus, should the claims not be found allowable, the last Office Action should be treated as a nonfinal one.

If this case does not go to allowance and if finality is maintained, kindly notify the undersigned attorney as soon as possible. It is important that the issue of finality be resolved as

soon as possible, since if finality is maintained, the Applicant must file a Petition under 37 CFR §1.181 (MPEP 1002 and 1002.02(c)(3)(a)) in order to preserve its rights.

4. Sections 6-7 of the Office Action: Rejection of Claims 1-13 and 21 under 35 USC §112(2)

The rejected claims are amended to recite a reinforced structure, thereby clarifying the relationship between the strip and the structure and obviating the §112(2) rejections.

5. Sections 8-9 of the Office Action: Rejection of Claims 1-4, 7-11, and 13 under 35 USC §102 in view of U.S. Patent 5,648,138 to Tingley;

Sections 10-11 of the Office Action: Rejection of Claims 1, 6, 12, and 19-34 under 35 USC §103(a) in view of U.S. Patent 5,648,138 to Tingley and U.S. Patent 5,640,825 to Ehansi et al.;

Section 12 of the Office Action: Rejection of Claims 19 and 26 under 35 USC §103(a) in view of U.S. Patent 5,648,138 to Tingley, U.S. Patent 5,640,825 to Ehansi et al., and U.S. Patent 5,637,375 to Hohman

All current art-based (§102 and §103) rejections are predicated on *Tingley* as the primary reference. As discussed in the interview, the current independent claims (1 and 19) both require nondirectional fibers embedded in the polymer matrix (see clauses b and c of claim 1; clauses a and a.ii of claim 19).

Tingley does not have this feature. *Tingley* describes reinforcing panels for wood structures which have parallel (i.e., directional) embedded fibers within their matrices, and only *Tingley*'s "haired up" fibers (which are outside the matrix and "nonembedded") are nondirectional. Note the description of the *Tingley* FIG. 5A embodiment at column 5 line 11-column 6 line 19, particularly at column 5 lines 45-51. Similarly, the *Tingley* FIG. 5B embodiment, as described at column 6 lines 29-53, has the aramid second fibers 31 parallel and directional (like the first fiber 30), and the aramid second fibers 31 are then nondirectionally "haired up" at the surface, outside the matrix. The *Tingley* FIG. 5C embodiment (as described column 6 line 54 onward)

does the same to a mat 35. The purpose of “hairing up” the fibers (i.e., making them nondirectional) outside the *Tingley* panel is so that when adhesives are applied to the panel, they will better adhere to its surface (see, e.g., column 5 lines 45-51).

The 12 May 2004 Office Action states (at the page 7 Response to Arguments) that column 6 lines 43-53 of *Tingley* discloses nonembedded nondirectional fibers, but this is incorrect: a more complete reading of column 6 lines 29-53 illustrates that the fibers are only nondirectional when “haired up” *outside the polymer matrix*, i.e., when they are nonembedded.

Thus, since *Tingley* does not disclose nondirectional fibers embedded within the panel – rather, *Tingley*’s fibers are only nondirectional outside the matrix of the panel – claim 1 (and thus its dependent claims) do not read on *Tingley*. Further, claim 19 is not rendered obvious by *Tingley* (as modified by *Ehansi et al.* and *Hohman*) because the alleged combination does not result in the structure recited in claim 19. It is further noted that since the purpose of the *Tingley* arrangement is to allow for better surface adhesion of adhesives, there is nothing in the *Ehansi et al.* and *Hohman* references that fairly suggests that *Tingley*’s fibers should be made nondirectional within the matrix; this would not assist in surface adhesion, or serve any benefit suggested in the references of record.

In view of the foregoing discussion, it was agreed in the interview that all claims appear novel and unobvious in view of the references of record.

6. In Closing

If any questions regarding the application arise, please contact the undersigned attorney. Telephone calls related to this application are welcomed and encouraged. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

For the Applicant,



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